



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,851	03/25/2004	Shih-Lin Lee	040-307	6672
35870	7590	12/15/2004	EXAMINER	
APEX JURIS, PLLC 13194 EDGEWATER LANE NORTHEAST SEATTLE, WA 98125			SMITH, RICHARD A	
			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No.	Applicant(s)	
	10/808,851	LEE, SHIH-LIN	
	Examiner	Art Unit	
	R. Alexander Smith	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

In this case, claim 1 is a Jepson claim and claim 2 is listed where the preamble of claim 1 stops and the body of claim 1 begins. Therefore misnumbered claims 3-7 have been renumbered as claims 2-6 respectively.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

In this case, U.S. 5,746,004 has been listed on the PTO-892 form.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "22" in figures 2 and 4 and "118" in figure 4. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The term "type" is used throughout the specification, including the title, the abstract and the claims, by the applicant to mean essentially a "tape", while the accepted meaning is:

type (tīp) *noun*

1. A number of people or things having in common traits or characteristics that distinguish them as a group or class.
2. The general character or structure held in common by a number of people or things considered as a group or class.
3. A person or thing having the features of a group or class.

Art Unit: 2859

4. An example or a model having the ideal features of a group or class; an embodiment: "*He was the perfect type of a military dandy*" (Joyce Cary).
5. A person regarded as exemplifying a particular profession, rank, or social group: *a group of executive types; a restaurant frequented by tourist types*.
6. A figure, representation, or symbol of something to come, such as an event in the Old Testament that foreshadows another in the New Testament.
7. a. A taxonomic group, especially a genus or species, chosen as the representative example in characterizing the larger taxonomic group to which it belongs. b. The specimen on which the original description and naming of a taxon is based.
8. *Printing*. a. A small block of metal or wood bearing a raised letter or character on the upper end that leaves a printed impression when inked and pressed on paper. b. Such pieces considered as a group. c. Printed or typewritten characters; print. d. A size or style of printed or typewritten characters; a typeface: *a sans-serif type*.
9. A pattern, a design, or an image impressed or stamped onto the face of a coin.

*verb***typed, typ-ing, types** *verb, transitive*

1. To write (something) with a typewriter; typewrite.
2. To determine the antigenic characteristics of (a blood or tissue sample).
3. To typecast.
4. To represent or typify.
5. To prefigure.

*verb, intransitive*To write with a typewriter; typewrite¹

These definitions are provided by the American Heritage® Dictionary of the English Language, Third Edition copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

In none of these definitions is "type" identifiable as a --tape--. The examiner requests that the Applicant change the specification according including the title.

Claim Rejections - 35 USC § 103

¹ *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

Art Unit: 2859

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over 6,276,071 to Khachatoorian in view of U.S. 6,182,916 to Lin.

Khachatoorian discloses a type rule housing structure comprising a housing, provided at its front end with an exit for said type rule; and with a braking block near its top end, a slip-resistant pad 22 and 24, provided over the periphery of said housing and extending from the upper edge of the front side of said housing toward the upper side and edges of left and right sides and a separate slip-resistant pad at the middle of the lower side extending toward the rear end of the lower side and wherein said slip-resistant pads protrude over each side (column 8, lines 56-59), wherein several recessed portions are further provided regularly at the lower side of said housing such that a slip-resistant protruding portion is formed correspondingly to facilitate gripping thereon, a locating block is further provided by extending from the junction of said lower side and the rear side of said housing in a manner that said locating block can be gripped by the finger of a user, said slip-resistant pad is made of a rubber material (column 8, lines 46-66), said slip-resistant pad is formed integrally with said housing through injection molding (column 8, lines 66-67).

Art Unit: 2859

Khachatoorian does not disclose said slip-resistant pad extending over the periphery of said housing from the upper edge of the front side of said housing toward and further around the rear side to enclose the type rule at the middle of the lower side such that the upper and rear sides can be enclosed completely, while only the rear end of the lower side of said housing is enclosed; and wherein said slip-resistant pad is protruded over each side of said housing to achieve a damping effect.

Lin discloses a slip resistant pad protruding over each side of said housing and over the top, back and bottom (figure 2), that a conventional product can be partially or entirely covered with an impact buffer, i.e., a damping effect, and slip resistant layer (column 1, lines 50-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the slip resistant pad, taught by Khachatoorian, to cover the top, back, and bottom rear and to include the impact protection, as taught by Lin, in order to increase the non-slip gripping area and to protect the device from impact should it fall.

With respect to the specific shape as claimed by Applicant: the shape is only considered to be an obvious modification of a slip-resistant pad because the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide. In re Dailey, 149 USPQ 47 (CCPA 1976). In this case, to protect the type rule housing structure, taught by Khachatoorian as modified by Lin, while not interfering with the brake or with the pencil holding mechanism.

Art Unit: 2859

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Khachatoorian and Lin as applied to claims 1-3, 5 and 6 above, and further in view of U.S. 6,216,356 to Li.

Khachatoorian and Lin together teach all that is claimed as discussed in the above rejections of claims 1-3, 5 and 6 except for the slip resistant pad and the housing being provided with different colors.

Li discloses an anti-skid pad 2 made of rubber, the bottom having recessed portions 23, and the body 1, pad 2 and bolt 3, i.e., housing structure, can have different colors so that the products can come in various combinations with different visual effects to stimulate the user's purchase (column 3, lines 56-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the housing, taught by Khachatoorian and Lin, by adding the different colors, as taught by Li, in order to stimulate the user's purchase.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related housing structures.

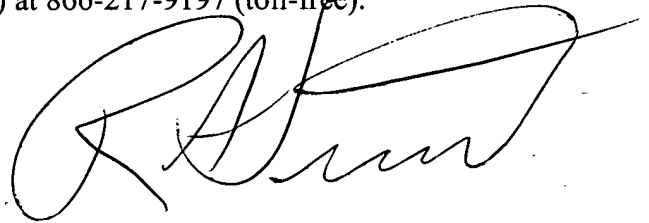
Art Unit: 2859

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Alexander Smith whose telephone number is 571-272-2251.

The examiner can normally be reached on Monday through Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. Alexander Smith', with a large, sweeping initial 'R'.

R. Alexander Smith
Patent Examiner
Technology Center 2800

RAS
November 13, 2004